

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/851895, now abandoned, and 60/20342 fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show 234, (page 20 III line 3), on Fig.4, 'internal or external hard drives such as 260' (page 20 III line 11), on Fig. 4, and fail to label 'communications port 266' (page 20 III line 14 and figure 3), on Fig.4.

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The abstract of the disclosure is objected to because the abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. The abstract as it stands refers to a computer system, not in the claims, and repeats information in the title. See MPEP § 608.01(b). Correction is required.

The disclosure is objected to because of the following informalities:

page 4, line 10: 'if other factors remaining unchanged' should be replaced by either, 'other factors remaining unchanged, ' or 'if other factors remain unchanged';

page 6, line 3 'has' should be replaced by 'have';

page 14 II A., lines 10-11 'XYZ parent is re-structured into one or more "Operating Companies" (110)' is ambiguous, may mean the entity XYZ disappears in the creation of Operating Companies, or it may not. Please clarify;

page 19, lines 3-7 'A separate Manufacturing and Sourcing Agreement between the respective parties regulates the obligation of the Operating Companies with respect to the use of the collateral IP. Owner 130 may use proceeds from the licensing agreement to pay the Manager 120 for managing the IP.' is not shown on the figure;

Page 20, lines 3 and 6 refer to 'central processing unit 234' and 'CPU 250' respectively, giving two different numbers to apparently the same structure.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eder (U.S. Patent Publication No. 2001/0034628) in view of Adams et al. (U.S. Patent 6,154,730 hereinafter referred to as Adams) and of Jacobs (U.S. Patent Publication No. 2003/0200164 hereinafter referred to as Jacobs).

Regarding claim 1, Eder teaches managing a business (**paragraph 0023, lines 2-4**) using impact of changes in business operation on value drivers and (**paragraph 0056, lines 1-3**) breaking down the value into tangible and intangible elements of value.

comprising:

(a) projecting one or more sources of future cash flow expected to be generated by the intangible assets of a business enterprise, (the calculation of the

present value of expected cash flows of paragraph 0056, lines 1-7
combined with paragraph 0056 lines 1-3 naming intangible elements of
value of the enterprise)

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the projection being based at least in part on information obtained over a telecommunications network from third-party sources, (the external databases

....enabl[ing] valuation of assets of paragraph 0075, lines 1-4)

Eder does not teach, but Adams teaches

b) providing a cash flow estimate expected to be generated by the intangible assets based on the projected one or more sources (Adams column 2 lines 51-54)

Claim 1 continued:and identifying ownership rights associated with the projected one or more sources (the collecting and pooling rights of column 1, lines 52-53)

c) transferring the identified rights to one or more special purpose vehicles, in a manner that effectively removes the respective cash flow(s) from the business enterprise's bankruptcy estate (column 1 lines 54-58)

d) issuing notes on behalf of at least one special purpose vehicle, using said transferred rights as collateral (the issuing securities of column 1, lines 59-60)

f) employing the revenue generated from the sale of said notes to finance at least a portion of the operating costs of the business enterprise (column 1 lines 61-63)

Adams thus teaches e) *selling said notes* but neither Eder nor Adams identify buyer of notes as a grantor trust which issues stock to investors. However, Jacobs teaches

e) ...to a grantor trust that issues stock to investors . (trust issues stock to the public or in a private placement of paragraph 4, lines 4-5)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify valuing of assets which may be tangible or intangible as taught by Eder and the transfer of rights to a special purpose vehicle as taught by Adams to adapt a grantor trust selling stock as taught by Jacobs. The motivation would be to value intangible assets and to securitize them, providing the tax advantages of a grantor trust.

Regarding claim 2, Jacob teaches

Claim 2) The method of claim 1 wherein the stock issued by the grantor trust is preferred stock. ([grantor] trust issues preferred stock of paragraph 4 line 4 and 5).

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eder (U.S. Patent Publication No. 2001/0034628, Adams (U.S. Patent 6,154,730) and Jacobs (U.S. Patent Publication No. 2003/0200164 hereinafter referred to as Jacobs) as applied to claim 1 above, and further in view of further in view of Madden, "Financing small bank holding companies: Securitization of Capital Securities.

Regarding claim 3, neither Eder nor Adams nor Jacobs teaches a Delaware grantor trust.

Claim 3) The method of claim 1 wherein the grantor trust is a Delaware grantor trust.

Madden teaches (Page 3, **STRUCTURE lines 3-8**).the Delaware grantor trust

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the grantor trust as taught by Jacobs to adapt a Delaware grantor trust as taught by Madden. The motivation would be to obtain the tax advantages of a Delaware trust.

Regarding claim 4, neither Eder nor Adams nor Jacobs teaches the grantor trust employing revenue from sale of said stock to purchase additional notes.

Madden teaches

the grantor employs the revenue generated from the sale of said stock to purchase additional notes **the proceeds from the issuance of the Trust's securities** (stock) **are invested in a like amount of ...debentures** (a debenture can be a note). This means that the Trusts sells the stock and the revenue (proceeds) is used to buy additional (a like amount, which means the same number) of debentures (notes) (**STRUCTURE lines 9-12**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to

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modify a Delaware grantor trust selling stock as taught by Jacobs and Madden to adapt the trust's using the revenue from sale of stock to buy additional notes as taught by Madden. The motivation would be to combine offering tax-advantaged trust preferred securities with replacing all the trust's assets with notes for the tax advantages.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda C. Perry whose telephone number is (571) 270-1466. The examiner can normally be reached on 7:30AM-5PM Mon-Fri, Alt Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571) 272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Signature: /Linda C Perry/

Application/Control Number: 10/800,220

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Examiner, Art Unit 4182

Name: Linda C. Perry

Date: 11/26/2007

/Thu Nguyen/

Primary Examiner, Art Unit 3661